

REMARKS

Claims 1 through 14, 33 through 64, and 66 through 94 are pending in this Application. Claim 65 has been canceled without prejudice or disclaimer and claims 1, 12, 48, and 56 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicants submit that the present Amendment does not generate any new matter issue.

PRELIMINARY STATEMENT

The present invention builds on the personal nutrition control dietary system disclosed in grandparent application No. 10/151,106 (U.S. 2003/0219513) involving multiple packages containing different types of food but of a uniform caloric content, e. g., 100 calories, thereby facilitating calorie counting simply by counting packages rather than counting calories directly. In such a system the packages having uniform calorie content, e.g., 100 calories, are provided by a food manufacturer with an attendant increased cost to the consumers by virtue of such convenience. Notwithstanding such increased cost, the dietary system has proved to be a commercial success.

The present invention provides flexibility and reduces the cost to the consumer by enabling the consumer to apportion food in accordance with a pre-determined number of calories. In accordance with an embodiment of the present disclosure, an apportioning device provides, in response to user input for a predetermined number of calories, a portion of food having that predetermined number of calories. Other embodiments of the present invention,

consistent with the objective of providing user flexibility and reduced user cost, include strategically prepared and marked packages and implementations.

Embodiments of the present invention enable a consumer to purchase predetermined quantities of different types of food having a desired caloric content and/or nutritional content per number of calories to facilitate nutritional control. This dietary system balances the convenience of prepackaged uniform caloric content food with the economic exigencies of the consumer. The dietary system also enables the consumer to purchase only so many calories or nutritional content of particular types of food as are desired. Neither the concepts underlying nor the recited features of the claimed invention are disclosed or suggested by the applied prior art.

The drawings were objected to as failing to show the features of claims 56 through 64.

In the statement of the objection, the Examiner asserted that there is no illustration of the packaging material for packaging a plurality of different types of food products. Applicant disagrees.

In the first paragraph of page 9 of the written description of the specification it is disclosed that the packaging material that packages the food product displays the nutritional content of a food product per a pre-determined approximate number of calories or Centicals. Clearly, such displays, which the packaging material comprises, are shown, for example, in Figs. 6, 7, 8, 9, and 10, wherein nutritional content per number of calories or Centicals is depicted. The packaging material encloses the food product and comprises the labels depicted, for example, in Figs. 6, 7, 8, 9, and 10. Clearly, and as one having ordinary skill in the art would easily recognize, these drawings do, indeed, illustrate the claimed packaging material.

Claim 56, for example, recites “[a] packaging material for packaging a plurality of different types of food products in an assembly of food products, the packaging material displaying the caloric content of each of the different types of food products as a pre-determined number of calories, wherein the pre-determined number of calories is 50 or a multiple thereof; wherein the assembly of food products comprise a plurality of packages of food products.” Fig. 6 depicts the claimed packaging material displaying the caloric content of food products as a pre-determined number (100) of calories.

Based on the foregoing, it is apparent, and one having ordinary skill in the art would easily recognize, that the claimed packaging material is adequately illustrated in the drawings. Applicant, therefore, submits that the imposed objection of claims 56 through 64, for lack of illustration in the drawings is not factually viable and, hence, solicits withdrawal thereof.

Claims 33, 40 through 42, 56 through 59, and 64 were rejected under obviousness-type double patenting over claims 1, 35 through 37, and 45 through 47 of copending Application Serial No. 11/147,253.

This rejection is traversed as improper on both a procedural ground and on substantive grounds. Procedurally, the Examiner rejected nine claims of the instant application over seven claims of the copending application, but the Examiner did not specifically identify what portions of which copending claims considered to correspond to those of the rejected claims, and relied upon to support the rejection. The Examiner’s disinclination to provide a one-to-one correspondence of the claim elements, an identification of the apparent differences, and a reasoned explanation why the instant claims would have been obvious over the copending claims, falls far short of a *prima facie* case of obviousness-type double patenting to which

Applicant can reasonably respond, thereby denying Applicant's right to procedural due process of law. *In re Mullin*, 481 F.2d 1333 (C.C.P.A. 1973).

The Examiner, at page 31 of the Office Action, offered the conclusory statement that "a packaging material for packaging a plurality of different types of food products in an assembly of food products" of instant claim 56 would have been obvious over copending claim 1 of Application Serial No. 11/147,253 because claim 56 "appears to [be] a routine modification of the device recited in claim 1 of the pending application 11/147253" and because "it would have been obvious...to recognize the device recited in claim 1...as the package for packaging the food products, since the functional limitation of this device is similar to the packaging material recited in claim 56 of the current application." A mere announcement of obviousness by the Examiner, without articulated reasoning with some rational underpinning falls far short of the establishment of obviousness mandated by 35 U.S.C. § 103.

At any rate, claim 56 recites "[a] packaging material for packaging a plurality of different types of food products in an assembly of food products, the packaging material displaying the caloric content of each of the different types of food products as a pre-determined number of calories, wherein the pre-determined number of calories is 50 or a multiple thereof; wherein the assembly of food products comprise a plurality of packages of food products." The current version of claim 1 of the copending application recites "[a] dietary system comprising a plurality of devices, each device having an indication thereon for indicating the same caloric content for a different type of food as that indicated by one or more of the other devices."

Quite clearly, copending claim 1 is directed to a dietary system comprising a "plurality of devices, each **device having an indication thereon for indicating the same caloric content for a different type of food.**" For example, the devices may be measuring spoon or measuring

cup-type devices, wherein the measurement is of caloric content rather than teaspoons, tablespoons, number of ounces, cups, etc. Instant claim 56, on the other hand, is clearly directed to a packaging material for packaging a plurality of different types of food products in an assembly of food products. It is inconceivable that a **packaging material** would be obvious over a **plurality of devices**. Not only are the claims directed to two entirely different structures, the packaging material of claim 56 merely **indicates** thereon a certain number of calories of a pre-packaged food product. This is in contrast to copending claim 1 which is a plurality of actual devices for **measuring** caloric content of food products.

The types of products (measuring devices of copending claim 1 vs. packing material of instant claim 56) to which the claims are directed are so diverse that a skilled artisan would not have ever been led to one from the other. No *prima facie* case of obviousness has been established.

Based on the foregoing, it is apparent that the subject matter of claim 56 would not have been obvious over the subject matter of claim 1 of copending Application Serial No. 11/147,253. Applicant, therefore, submits that the imposed obviousness-type double patenting rejection of claims 33, 40 through 42, 56 through 59, and 64 as being obvious based on claims 1, 35 through 37, and 45 through 47 of copending Application Serial No. 11/147,253 is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 33, 40 through 42, 56 through 59, and 64 were rejected under obviousness-type double patenting over claims 23, 37, 51, 58, 59, 63, 64, 97, 106, 107, 110, 116, 117, 121, and 122 of copending Application Serial No. 10/151,106.

This rejection is traversed as improper on both a procedural ground and on substantive grounds. Procedurally, the Examiner rejected nine claims of the instant application over fifteen claims of the copending application, but the Examiner did specifically identify what portions of which copending claims considered to correspond to those of the rejected claims, and relied upon to support the rejection. The Examiner's disinclination to provide a one-to-one correspondence of the claim elements, an identification of the apparent differences, and a reasoned explanation why the instant claims would have been obvious over the copending claims, falls far short of a *prima facie* case of obviousness-type double patenting to which Applicant can reasonably respond, thereby again denying Applicant's right to procedural due process of law. *In re Mullin*, 481 F.2d 1333, *supra*.

The Examiner, at page 31 of the Office Action, offered a conclusionary statement that "claim 56 of the current application recites similar limitations as claim 23 of the pending application 10/151106, except for the type of food packaged in the package" The Examiner concludes that "it would have been obvious...to incorporate any additional information such as the type of food on the package (in addition to the calorie content) to identify the product." Again no articulated reasoning with some rational underpinning has been presented-just an announcement of obviousness.

At any rate claim 56 recites "[a] packaging material for packaging a plurality of different types of food products in an assembly of food products, the packaging material displaying the

caloric content of each of the different types of food products as a pre-determined number of calories, wherein the pre-determined number of calories is 50 or a multiple thereof; wherein the assembly of food products comprise a plurality of packages of food products.” The current version of claim 23 of the copending application recites “[a] food unit comprising: (a) a package; (b) a type of food packaged in said package; (c) an indication in print on or in said package, said indication: (i) stating a predetermined caloric content of 100 calories for the entire package; and (ii) indicating an availability of other food units of a plurality of different types of foods, each of said plurality of different types of foods having said predetermined caloric content.”

Quite clearly, copending claim 23 is directed to a **single package** of food of a food type with an indication on or in that single package of a predetermined caloric content of 100 calories, along with an indication of availability of other food units. Instant claim 56, on the other hand, is clearly directed to a **packaging material** for packaging a plurality of different types of food products in an **assembly** of food products. Claim 23 of the copending application is not concerned with any “packaging material” nor with an “assembly” of food products. Instant claim 56, on the other hand, is unconcerned with any indication of availability of other food units. In fact, the assembly of food products of claim 56 would already make clear to a consumer what other related food products are available by their display within the “assembly.” There would be no need to inform consumers **in print** of the particular availability. It is inconceivable that a **packaging material** would be obvious over a **food unit** comprising a package. Not only are the claims directed to two entirely different structures, the packaging material of claim 56 merely **indicates** thereon a certain number of calories of a pre-packaged food product. This is in contrast to copending claim 23 which is a food unit comprising an actual “package,” wherein there is a **printed indication** in or on the package indicating both 100

calories of food within the package **AND availability** of other food units having similar caloric content,

The types of products (package with a printed indication of availability of food units of similar caloric content of copending claim 23 vs. packing **material** of instant claim 56) to which the claims are directed are so diverse that a skilled artisan would not have ever been led to one from the other. No *prima facie* case of obviousness has been established.

Based on the foregoing, it is apparent that the subject matter of claim 56 would not have been obvious over the subject matter of claim 23 of copending Application Serial No. 10/151,106. Applicant, therefore, submits that the imposed obviousness-type double patenting rejection of claims 33, 40 through 42, 56 through 59, and 64 as being obvious based on claims 23, 37, 51, 58, 59, 63, 64, 97, 106, 107, 110, 116, 117, 121, and 122 of copending Application Serial No. 10/151,106 is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 48 through 55 and 93 were rejected as non-statutory under 35 U.S.C. § 101.

Citing *In re Bilski* (*Fed. Cir. 2007-1130, 10/30/2008*), the Examiner asserted that the subject matter of claims 48 through 55 and 93 is directed to non-statutory subject matter because the claimed method does not transform underlying subject matter to a different state or thing, nor is the claimed method tied to another statutory class. This rejection is traversed.

The claim analyzed by the court in *Bilski* was directed to a “method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price comprising” various steps. It is noteworthy that the *Bilski* claim, unlike claims 48 through 55 and 93 in the instant case, was not restricted to any apparatus or machine for implementing the recited method. However, claims 48 through 55 and 93 are directed to a “**computer-**

implemented method.” Claims directed to methods implemented on computers are time-tested as to their statutory nature within the meaning of 35 U.S.C. § 101. Computers are, simply, **machines**. A computer is employed to automatically perform a series of steps, or algorithms, to implement certain processes in accordance with a program or set of instructions but it is a “machine” nonetheless that performs the functions implementing the claimed method, i.e., a **“computer-implemented method.”** Thus, the method recited in claims 48 through 55 and 93, being implemented on a computer, is clearly tied to a machine.

Moreover, unlike *Bilski*, the instant claims are not directed to a mere “business method” of “initiating a series of transactions between said commodity provider and consumers of said commodity wherein said consumers purchase said commodity at a fixed rate...,” “identifying market participants,” and “initiating a series of transactions between said commodity provider and said market participants at a second fixed rate...” Rather, the instant claims actually transform an input corresponding to a food product into nutritional content of the food product in accordance with a pre-determined number of calories, wherein the nutritional content is then presented to a consumer in accordance with the pre-determined number of calories.

Based on the foregoing, it is apparent that the subject matter of claims 48 through 55 and 93, being directed to a “computer-implemented” method, and thus tied to a specific machine, and also transforming a food product input into a presentation of nutritional content in accordance with a pre-determined number of calories, clearly falls within the ambit of 35 U.S.C. § 101. Applicant, therefore, submits that the imposed rejection of claims 48 through 55 and 93, for failing to recite statutory subject matter is not legally viable and, hence, solicits withdrawal thereof.

Claims 56 through 64 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner asserted that the claimed “packaging material” is not disclosed in the specification. This rejection is traversed.

As previously argued in traversing the drawing objection, there is a clear disclosure, in the first paragraph on page 9, of the written description of the specification, for example, of the claimed “packaging material.” The cited portion of the specification recites “...packaging material that packages the food product. The packaging material displays the nutritional content of a food product per a pre-determined approximate number of calories or Centicals...”

The inquiry to be made regarding a rejection under the written description clause of 35 U.S.C. 112, first paragraph, pertains to whether the disclosure (specification, drawings, claims) as originally filed reasonably conveys to the journeyman practitioner in the art that the inventor had possession at that time of that which he now claims. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90, 98 (CCPA 1976). Clearly, the disclosure at page 9, first paragraph of the specification, reasonably conveys to one having ordinary skill in the art that the inventor had possession at the time of filing the application of the “packaging material” now claimed.

Based on the foregoing, it is apparent that the subject matter of claims 56 through 64 is clearly supported by the original disclosure within the meaning of 35 U.S.C. § 112, first paragraph. Applicant, therefore, submits that the imposed rejection of claims 56 through 64 as being based on an inadequate written description is not factually viable and, hence, solicits withdrawal thereof.

Claims 2 through 4, 12, and 13 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

In the statement of the rejection the Examiner asserted that the recitation in claim 2 of “the device is configured to correlate weight of the apportioned food with calories and to cease apportioning food when a correlated weight substantially corresponds to the predetermined number of calories” is not supported by a disclosure that would enable one skilled in the art to make and use the claimed subject matter. This rejection is traversed.

Firstly, lack of enablement under the first paragraph of 35 U.S.C. § 112 is a question of law. *U.S. Steel Corp. V. Philips Petroleum Co.*, 865 F.2d 1247, 9 USPQ2d 1461 (Fed Cir. 1989); *U.S. V. Teletronic Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988). In rejecting a claim under the first paragraph of 35C.S.C. § 112 for lack of adequate enabling support , it is incumbent upon the Examiner to establish a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art would not be able to practice the claimed invention, armed with the supporting specification, without undue experimentation. *In re Cortright*, 165 F.3d1353, 49 USPQ2d 1464 (Fed. Cir. 1999) *In re Brana*, 51 F.2d 1560, 34 USPQ2d. 1436 (Fed, Cir, 1995); *In re Marzocchi*, 439 F.2d 220 169 USPQ 367 (CCPA1971). Applicant emphasizes that a patent disclosure is directed to one having ordinary skill in the art. *In re Howarth*, 654 F. 2d 103, 210USPQ589 (CCPA 1981). Moreover, and quite significantly, it has been repeatedly held that the scope of enablement varies inversely with the degree of predictability in the art, i.e., enablement is a function of the complexity of the involved subject matter. *Northern Telecom, Inc. V. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2D 1321 (Fed. Cir, 1990); *U.S. v. Teletronics Inc.*, supra. Applicant stresses that a patent specification is presumed enabling in the absence of a reason to doubt the objective truth of the statements contained therein. *In re Cortright*, supra. *In re Brana*, supra; *In re Marzocchi*, supra.

In applying the above legal tenets to the exigencies of this case, Applicant submits that the Examiner has not established a *prima facie* basis to deny patentability to the claimed invention under the first paragraph of 35 U.S.C. §112 for lack of adequate enabling support.

Specifically the examiner has not overcome the presumption of enablement, as by advancing technological reasoning to doubt the statements in the specification, or by establishing that the claimed is inherently unbelievable or involves implausible scientific principles. *In re Cortright, supra.*, bearing in mind that the present invention does not flirt with the fringes of human ken, or involve a high degree of unpredictability. The Examiner's attempt to overcome the presumption of enablement falls far short of the mark.

The Examiner cited certain language from the written description of the specification, *to wit*, "...this device (1) can accept the desired total caloric content of the package and, accessing (2) the conversion table or ERP (3) described above, can produce the portion or portions needed to result in the calorie-based portions and/or total caloric content" (page 17, lines 21-23 of the instant specification) but then asserts that this disclosure "does not enable one of ordinary skill in the art to make and/or use the invention" (Office Action-page 4).

On the contrary, this cited portion of the specification does provide enabling disclosure for the subject matter claimed. A customer desiring to purchase a predetermined number of calories worth of a particular food simply inputs that predetermined number of calories to the device, i.e., "this device (1) can accept the desired total caloric content of the package." For example, a customer may want to purchase 100 calories worth of a food, wherein a package of that food totals 1,000 calories. In order to determine the amount of food to be separated from the package so as to result in the desired 100 calories, there is a conversion table or ERP (see Figs 15a, b, and c)) provided for determining the number of calories present in corresponding

weights of particular foods. Employing this table, or ERP, it is a simple matter to determine how much, e.g., weight, of the particular food must be provided in order to correspond to the predetermined caloric content, e.g., 100 calories. That is, the weight of a particular food is input to the ERP and the ERP then maps this weight of the particular food to a corresponding caloric value and outputs that caloric value.

Thus, in accordance with page 17 of the written description of the specification, and Figs. 15 a, b, and c, the total caloric content of a food package is known, and a table or ERP is accessed in order to determine the portion of the food package needed to result in the desired number of calories, and the amount of food corresponding to that desired number of calories is provided (e.g., by slicing off the amount of food corresponding to the desired number of calories). A slicer, or other cutting machine, depicted as portioning device 1 in Fig. 15a, may be employed to provide the portion of food corresponding to the number of calories as provided by the table or ERP.

Based on the foregoing, it is quite apparent that one having ordinary skill in the art would have absolutely no difficulty practicing the inventions defined in claims 2 through 4, 12, and 13, and would clearly have been enabled to do so given the guidance of the present disclosure, certainly without undue experimentation, even without any experimentation. Applicant, therefore, submits that the imposed rejection of claims 2 through 4, 12, and 13 under the first paragraph of 35 U.S.C. § 112 for lack of adequate enabling support is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 1 through 14, 40 through 47, 56 through 65, and 88 through 92 were rejected under 35 U.S.C. § 112, second paragraph.

The Examiner asserted that independent claims 1, 40, and 56 “do not appear to have any transitional phrase. Independent claims are required to have at least one transitional phrase that separates the body of the claim from the preamble” (Office Action-page 5). This rejection is traversed as clearly legally erroneous.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a **question of law**. *Personalized Media Communications LLC v. U.S. International Trade Commission*, 161 F.3d 696 (Fed. Cir. 1998); *Tillotson, Ltd v. Wlaboro Corp.*, 831 F.2d 1033 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the Examiner must provide a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope of protection defined by a claim. *In re Okuzawa*, 537 F.2d 545 (C.C.P.A. 1976). Significantly, consistent judicial precedents holds that **reasonable precision** in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Zoltek Corp. v. United States*, 48 Fed. Cl. 240 1257 (Fed. Cl. 2000); *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870 (Fed. Cir. 1993); *North American Vaccine, Inc., v. American Cyanamid Co.*, 7 F.3d 1571 (Fed. Cir. 1993); *U.S. v. Teletronics Inc.*, 857 F.2d 778, (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986).

Significantly, the Examiner does not even so much as suggest that one having ordinary skill in the art would not be able to understand the scope of the claimed invention when reasonably interpreted in light of the disclosure which is, of course, the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870 (Fed. Cir. 1993); *North American Vaccine, Inc., v. American Cyanamid Co.*, *supra*. Instead, the Examiner invents a litmus test for the legal

conclusion of indefiniteness requiring a “transitional phrase” even though the claim is definite. This approach is clearly legally erroneous.

Applicants are unaware of any requirement in the patent statute, rules, or case law requiring a “transitional phrase”. The Examiner is hereby challenged to provide a legal basis for requiring a “transitional phrase.” This, the Examiner cannot do, because there is no such requirement.

The question to be answered under 35 U.S.C. § 112, second paragraph is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed; not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Claim 1 provides a clear statement of the subject matter claimed, *viz.*, “[a] device for apportioning food, the device being configured to provide, in response to user input specifying a predetermined number of calories, a portion of food having the predetermined number of calories.” Claim 40 provides a clear statement of the subject matter claimed, *viz.*, “[a] plurality of packages of food, wherein each package of food has an indication thereon of a uniform caloric content of 50 calories or multiples thereof.” Claim 56 provides a clear statement of the subject matter claimed, *viz.*, “[a] packaging material for packaging a plurality of different types of food products in an assembly of food products, the packaging material displaying the caloric content of each of the different types of food products as a pre-determined number of calories, wherein the pre-determined number of calories is 50 or a multiple thereof; wherein the assembly of food products comprise a plurality of packages of food products.” There is nothing indefinite about

these claims nor has the Examiner indicated any indefiniteness associated with these claims. Accordingly, the claims are definite, within the meaning of 35 U.S.C. § 112, second paragraph.

Applicant notes that claim 12 has been clarified by making it depend from claim 5, which does provide an antecedent basis for “the particular size.” Accordingly, the stated basis for the rejection of claim 12 has been overcome.

Based on the foregoing, it is clear that the subject matter of claims 1 through 14, 40 through 47, 56 through 65, and 88 through 92 is definite within the meaning of 35 U.S.C. § 112, second paragraph. Applicant, therefore, submits that the imposed rejection of claims 1 through 14, 40 through 47, 56 through 65, and 88 through 92 as failing to present “transitional phrases,” is not legally viable and, hence, solicits withdrawal thereof.

Claims 1, 9, 48, 49, and 51 were rejected under 35 U.S.C. § 102 (b) as anticipated by *Missler et al.* (US 6,359,239).

This rejection is traversed. Specifically, claim 1 recites “[a] device for **apportioning food**, the device being configured to **provide, in response to user input specifying a predetermined number of calories**, a portion of food having the **predetermined** number of calories.” Thus, the device must “apportion” food or be capable of apportioning food and the device must be capable of providing a portion of food having a **predetermined** number of calories, the providing being responsive to a user input specifying that predetermined number of calories.

In contrast, *Missler et al.* disclose a combination cutting board and weighing scale. A user cuts off a portion of food on the cutting board and that portion of food is then slid over to the weighing scale to indicate a weight for that sliced off portion of food. *Missler et al.* also

provide for a caloric content of the sliced off portion of food to be displayed. However, the device of *Missler et al.* does not “apportion” anything, and it clearly does not apportion food having a **predetermined** number of calories.

The “user input” is either the food portion cut off by the user and placed on the scale and/or a user indication of whether weight or calories is to be indicated for the food portion. The number of calories of the food portion is what it is. But it is **not a predetermined** number of calories. Rather, whatever number of calories is involved in *Missler et al.* is **not preset** by user input, as in the claimed invention where a portion of food having a **predetermined number** of calories is provided **in response to user input for that predetermined number of calories**. The Examiner referred to “col. 2, lines 41-16” [lines 41-46?] of *Missler et al.* for a teaching of a “predetermined” number of calories. No such teaching can be found in the cited portion of *Missler et al.* or anywhere else. The cited portion of *Missler et al.* merely explains how a user may select whether the readout display indicates weight or calories and how a particular food is identified so that a number of calories associated with a particular weight of that particular food can be determined. But, it does **not** disclose or suggest anything about providing a portion of food having a **predetermined** number of calories in response to user input for that **predetermined** number of calories.

At pages 32-33 of the Office Action, the Examiner asserted that the claims do not specifically identify the user input as being a predetermined number of calories input to the device. However, claim 1 does recite that the device provides “in response to user input, a portion of food having a predetermined number of calories.” There is but one interpretation - that the user must provide the “predetermined number of calories.” However, in the interest of compact prosecution and to dispel any doubt as to where the predetermined number of calories originates, claim 1 has been clarified to recite that the user provides the predetermined number of

calories (i.e., the features of claim 65 have now been incorporated into claim 1 and claim 65 has been canceled). Accordingly, *Missler et al.* do not anticipate the subject matter of instant claims 1 and 9.

Independent claim 48 recites, *inter alia*, “deriving, based on the caloric content, **nutritional content** of the food product in accordance with a pre-determined number of calories; and presenting the **nutritional content** to a consumer in accordance with the pre-determined number of calories.” As previously argued, there is no disclosure in *Missler et al.* regarding a pre-determined number of calories. Moreover, there is no disclosure in *Missler et al.* regarding either a derivation of or a presentation of **nutritional content** of the food product, let alone in accordance with a pre-determined number of calories.

The Examiner referred to col. 5, lines 37-45, and col. 5, lines 61-67, for a disclosure of “deriving, based on the caloric content, nutritional content of the food product in accordance with a pre-determined number of calories,” and “presenting the nutritional content to a consumer in accordance with the pre-determined number of calories,” respectively. These cited portions of *Missler et al.* are directed to allowing a user to input information specifying parameters to be measured or displayed, and to choosing between various display options, such as specifying weight or calories to be displayed. But weight is not a measure of “nutritional content” and calories is not a measure of “nutritional content,” as claimed, because the instant claims explicitly denote a difference between “calories” and “nutritional content” by reciting that there is a derivation and presentation of “nutritional content” “in accordance with” a “pre-determined number of calories.” One clearly would not derive or present “calories” in accordance with a “pre-determined number of calories.” Therefore, it is clear from the instant claim language, as well as from the instant disclosure, that nutritional content is something

different from the number of calories. Accordingly, *Missler et al.* do not anticipate the subject matter of instant claims 48, 49, and 51.

The above argued differences between the claimed invention and *Missler et al.* undermine the factual determination that the disclosure of *Missler et al.* anticipates any of the rejected claims. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claims 1, 9, 48, 49, and 51 as being anticipated by *Missler et al.* under 35 U.S.C. § 102 (b) is not legally viable and, hence, solicits withdrawal thereof.

Claims 40 through 42, 44, 91, and 92 were rejected under 35 U.S.C. § 102 (b) as anticipated by *Rhee* (US 2001/0043968).

This rejection is traversed. Specifically, Independent claim 40 recites “A **plurality of packages** of food, wherein each package of food has an indication thereon of a **uniform** caloric content of 50 calories or multiples thereof. *Rhee* fails to disclose a “plurality of packages” with each package having an indication of a “uniform” caloric content.

The Examiner relied on Figs. 1c and 1d of *Rhee*. These figures of *Rhee* depict separate embodiments of an invention, with Fig. 1c depicting a roll cake having divided portion lines and caloric content indicators for each portion, and Fig. 1d depicting a length of candy having divided portion lines and caloric content indicators for each portion.

No single embodiment of *Rhee* can be considered a **plurality of packages** wherein each package of the **plurality of packages** wherein each package has an indication of a **uniform** number of calories, e.g., where each package in the plurality of packages may contain 100

calories. Fig. 1c of *Rhee* may depict a uniform number of calories (300) of different portions within a **single** package, just as Fig. 1d depicts a uniform number of calories (200) of portions within a **single** package. However, nowhere does *Rhee* disclose a plurality of packages, let alone the concept of having each package of food within a **plurality of packages** of food having an indication thereon of a **uniform** caloric content. Accordingly, *Rhee* cannot anticipate the subject matter of instant claims 40 through 42, 44, 91, and 92.

Moreover, Applicant separately argues the patentability of claims 41, 42, and 44. Claim 41 recites “wherein each package of food has an indication thereon of **nutritional information per uniform caloric content**.” *Rhee* discloses no such indication of “nutritional information,” let alone “**nutritional information per uniform caloric content**.” Paragraph [0021] of *Rhee*, cited by the Examiner as disclosing this feature, contains no such teaching. The cited paragraph discloses information regarding calorie content, but is silent as to “nutritional information.” To whatever extent the Examiner may have assumed that calories constitute “nutritional information,” the Examiner should be made aware that on this record and in the context of the present invention, calorie content is explicitly excluded from and distinct from “nutritional information,” and would have been so understood by one having ordinary skill in the art. This is clear from the claim language itself, reciting “**nutritional information per uniform caloric content**”, clearly disabusing the notion of “calorie content per uniform calorie content” which simply makes no sense. Therefore, it is clear from the instant claim language, as well as from the instant disclosure, that nutritional information is something different from caloric content.

Claim 42 recites “wherein at least two of the packages contain different types of foods.” The Examiner pointed to Figures 1c and 1d as showing “different types of food,” viz., roll cake

and length of candy. The Examiner's analysis is flawed because, as explained above, Figs. 1c and 1d of *Rhee* depict **distinctly different** embodiments, each embodiment directed to a particular type of food. Unlike claim 42, *Rhee* does not disclose two packages being part of the same "plurality of packages," with each package having an "indication thereon of a **uniform** caloric content of 50 calories or multiples thereof."

Claim 44 recites "wherein the indication is in the form of a table." *Rhee* discloses no such "table." Contrary to the Examiner's assertion that a table is disclosed in *Rhee* by its disclosure of indications of caloric content on the front of the package in Figs. 1c and 1d, these are merely labels of caloric content. They are neither "tables" nor are they tables depicted on a "plurality of packages," as claimed.

The above argued differences between the claimed invention and *Rhee* undermine the factual determination that the disclosure of *Rhee* anticipates any of the rejected claims. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, supra.; *Kloster Speedsteel AB v. Crucible Inc.*, supra. Applicant, therefore, submits that the imposed rejection of claims 40 through 42, 44, 91, and 92 as being anticipated by *Rhee* under 35 U.S.C. § 102 (b) is not legally viable and, hence, solicits withdrawal thereof.

Claims 6, 50, 55, 65, and 93 were rejected as obvious under 35 U.S.C. § 103 based on *Missler et al.* (US 6,359,239).

This rejection is traversed. As previously argued *Missler et al.* do not disclose or remotely suggest, "[a] device for **apportioning food**, the device being configured to **provide, in response to user input**, a portion of food having a **predetermined** number of calories," as in claim 1, or "deriving, based on the caloric content, **nutritional content** of the food product in

accordance with a pre-determined number of calories; and presenting the **nutritional content** to a consumer **in accordance with the pre-determined number of calories,**” as in claim 48. There is no apparent basis on which to reasonably conclude that one having ordinary skill in the art would have found the claimed subject matter obvious within the meaning of 35 U.S.C. § 103. Accordingly, *Missler et al.* would not have rendered obvious claims 6, 50, 55, and 93, dependent on claims 1 and 48.

The Examiner’s assertion that one of ordinary skill in the art would have recognized that a user “is **capable** of apportioning the food product into any desired calorie (or weight) amount using the device of the prior art...and therefore, specifying a particular calorie amount (or set of calorie amounts) for a specific purpose requires only a routine skill in the art” (Office Action- pages 7-8) is legally flawed. The determination of what a person skilled in the art is “capable” of is not the test for obviousness. The test for obviousness is what the combined teachings of references **would have suggested** to one having ordinary skill in the art. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Nothing within *Missler et al.* suggests a “pre-determined number of calories” at all, so there clearly would have been no suggestion of “**wherein the predetermined number of calories** is selected from the group consisting of about 50, 100, 150, 200, 250, 300, 350, 400, 450, 500, 550, 600, 750, and 1000,” as recited in claim 6, with similar recitations in claims 50, 55, and 93. Moreover, it is only Applicant, and not *Missler et al.*, who suggests inputting a desired number of calories of the food to be apportioned by the claimed device.

Based on the foregoing, the conclusion is inescapable that one having ordinary skill in the art would **not** have found the subject matter of claims 6, 50, 55, and 93 as a whole obvious within the meaning of 35 U.S.C. § 103. Applicant, therefore, submits that the imposed rejection of claims 6, 50, 55, and 93 (claim 65 has been canceled) as being obvious under 35

U.S.C. § 103 based on *Missler et al.* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 2 through 5, 7, 8, and 10 through 13 were rejected as obvious under 35 U.S.C. § 103 based on *Missler et al.* (US 6,359,239) in view of *Sly* (US 4,300,645).

This rejection is traversed. Specifically, the Examiner asserted that *Sly* discloses a device configured to cease apportioning food when the desired weight of food has been deposited on a scale. But that disclosure does not bridge the lacuna between the claimed invention and *Missler et al.*

Sly merely discloses the deactivation of a food slicer when a desired weight of a sliced food has been deposited on a platform. *Missler et al.* merely disclose the conversion of a weight of a particular food into an associated number of calories for that food. Clearly, *Sly* does not cure the previously argued deficiencies of *Missler et al.* regarding a user input of a predetermined number of calories and providing a portion of food having that predetermined number of calories. Since neither of the applied references discloses or suggests these features, even if the applied references are combined as proposed by the Examiner, and Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result, noting that claims 2 through 5, 7, 8, and 10 through 13 depend from claim 1 which contains the argued features. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988).

Applicant, therefore, submits that the imposed rejection of claims 2 through 5, 7, 8, and 10 through 13 as being obvious under 35 U.S.C. § 103 based on *Missler et al.* and *Sly* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claim 14 was rejected as obvious under 35 U.S.C. § 103 based on *Missler et al.* (US 6,359,239) in view of *Prussia* (US 5,372,030).

This rejection is traversed. Specifically, the Examiner asserted that *Prussia* discloses a fruit and vegetable sorting machine. But that disclosure does not cure the previously argued deficiencies of *Missler et al.*, viz., a user input of a pre-determined number of calories and providing a portion of food having that predetermined number of calories.

Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicant again does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicant, therefore, submits that the imposed rejection of claim 14 as being obvious under 35 U.S.C. § 103 based on *Missler et al.* and *Prussia* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 43, 56 through 59, 64, and 88 through 90 were rejected as obvious under 35 U.S.C. § 103 based on *Rhee* (US 2001/0043968).

This rejection is traversed. In rejecting claim 43, the Examiner asserted that it would have been obvious that two different packages of food may have different weights, specifically referring to the roll cake and length of candy in Figs 1c and 1d, respectively, in *Rhee*. However, the Examiner apparently ignored the specific claim language requiring a “**plurality of packages.**” As previously argued in traversing the rejection of claim 40, from which claim 43 depends, *Rhee* does not disclose or suggest a single embodiment of a **plurality of packages** wherein each package of the **plurality of packages** wherein each package has an indication of a

uniform number of calories. Accordingly, the Examiner did not establish a *prima facie* case of obviousness with regard to the subject matter of claim 43 based on *Rhee*.

Independent claim 56 recites, *inter alia*, “packaging material for packaging a **plurality of different types of food products** in an assembly of food products.” The Examiner asserted that *Rhee*, in paragraph [0008] discloses an assembly of food products. This cited portion of *Rhee* refers only to “a package for food products” and “a packed food product.” Nowhere in *Rhee* is there any disclosure, suggestion or hint of “an assembly of food products.” Accordingly, the Examiner did not establish a *prima facie* case of obviousness with regard to the subject matter of claim 43 based on *Rhee*.

At pages 34 through 35 of the Office Action, the Examiner asserted, that the packing material depicted in Fig. 3f of *Rhee* is for a plurality of different food products in that at least two sections of the package (a and b) appear to comprise different food products. But *Rhee* does **not** disclose that the sections of the package in Fig. 3f comprise different foods. If one improperly resorts to assumptions, rather than the required facts, to support the ultimate legal conclusion of obviousness, the rejection must still fail. This is because even if it is improperly assumed that the disclosure of a “lunch-basket” implies different foods, *Rhee* still lacks any teaching or suggestion of “packaging material for packaging a **plurality of different types of food products** in an assembly of food products.” In the interest of compact prosecution, claim 56 has been clarified by reciting “assembly of food products” and “wherein the assembly of food products comprises a plurality of packages of food products.”

There is no way to reasonably interpret *Rhee*’s Fig. 3f package as an assembly of food products “wherein the assembly of food products comprise a plurality of packages of food products.” This is because Fig. 3f of *Rhee* depicts but a **single** package, at best.

Claim 58 recites “wherein the packaging material further displays **nutritional content** of each of the different types of food **product per the predetermined number of calories** for each of the different types of food products.” *Rhee* discloses no such feature. *Rhee* merely displays a number of calories, not nutritional content. As previously argued, in the context of the present invention, a number of calories does not constitute “nutritional content. As one having ordinary skill in the art would have understood from the present disclosure, the number of calories is distinct and excluded from the “nutritional content”. Indeed, the explicit claim language recites “nutritional content...**per the predetermined number of calories.**” It simply makes no sense to speak of “calories per predetermined number of calories.” Therefore, “nutritional content” must refer to something other than calories. For example, as recited at page 21, lines 16 through 17 of the written description of the specification, “[t]he nutritional content can include weight, fats (saturated and unsaturated), protein, carbohydrates, vitamins, minerals, etc.”

Claim 88 recites “wherein the plurality of packages are within an **arrangement of packages.**” Claim 89 recites “wherein the arrangement comprises a container.” Claim 90 recites “wherein the arrangement comprises a display.”

The Examiner asserted that in Fig. 3f, *Rhee* discloses the subject matter of claims 88 through 90. That determination is not accurate. *Rhee*’s Fig. 3f merely illustrates a “lunch-basket” wrapped with a wrapper displaying the number of calories of portions of foods. It comprises a single package. That is not an “arrangement of packages,” as claimed.

Based on the foregoing Applicant submits that the imposed rejection of claims 43, 56 through 59, 64, and 88 through 90 as being obvious under 35 U.S.C. § 103 based on *Rhee* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 33 through 39, 45 through 47, 61 through 63 and 85 through 87 were rejected as obvious under 35 U.S.C. § 103 based on *Rhee* (US 2001/0043968) in view of *Arrendale* (US 2004/0045202).

This rejection is traversed. Specifically, independent claim 33 recites “the package having an indication thereon of the approximate **number of calories of the food in the package**; and an indication thereon of the approximate number of calories of one of the multiple servings of the food in the package, wherein the two approximate numbers are different.” On page 16 of the Office Action the Examiner acknowledged that “*Rhee* does not explicitly disclose, the package having an indication thereon of the number of calories of the food in the package (the total number of calories of food in the package)”. The Examiner’s choice of words - “does not explicitly”- makes it sound that somewhere lurking in *Rhee*’s disclosure is a suggestion of this clearly missing feature. But there is no such suggestion in *Rhee*.

The Examiner takes attempts to fill in what is clearly missing by asserting that *Rhee* implicitly discloses the total number of calories because that number is merely the sum of the number of calories in each of the portions. It cannot be gainsaid that the approximate number of calories of the food in the package is the sum of the approximate number of calories in each of the multiple servings within the package. But that calculation is not what *Rhee* discloses or what *Rhee* contemplated as part of the disclosed invention. Apart from that calculation, the Examiner provided no basis upon which to conclude that one having ordinary skill in the art would have been realistically impelled to indicate **both** of these numbers on the package. Indeed, the Examiner cannot point to any prior art disclosing two such indications on a package of food. This clear difference between the claimed invention and *Rhee* is functionally significant, because it provides the distinct advantage to the consumer of knowing how many calories are in the

entire package of food as well as the number of calories being consumed per serving, and further provides an easy way for the consumer to keep track of his/her caloric intake.

As a fallback position to airbrushing *Rhee*, the Examiner turned to *Arrendale, III et al.* and asserted the disclosure of a package having an indication thereon of the approximate number of calories of the food in the package, referring specifically to Fig. 1. That determination is not accurate. But even if it is, which it is not, the mere fact that one reference discloses a package of food with an indication of the total number of calories of food in a package, and another reference provides for an indication of individual servings of food in a package, does not, without more, lead to the conclusion that one having ordinary skill in the art would have been realistically led to provide for both indications on a single package of food. The Examiner's conclusory approach falls far short of favoring the record with the requisite explicit reasoning with some rational underpinning. **The selective hindsight combination of references that show various elements of the claim generally does not suffice to establish obviousness.** See KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) ("[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.").

It is only by improperly trespassing on Applicant's disclosure that the Examiner's obviousness conclusion finds support. But this approach is legally erroneous. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082 (Fed. Cir. 1985).

At any rate, *Arrendale, III et al.* do not disclose an indication of the total number of calories in a package of food. In Fig. 1 of *Arrendale, III et al.*, on which the Examiner relied, there is depicted a front side label on which **no** indication of a number of calories appears, and a back side on which appears a label with an indication of the number of calories **per serving**. **There is no indication of the number of calories of food within the whole package.**

At pages 35 through 36 of the Office Action, the Examiner argued that *Arrendale, III et al.* disclose multiple servings of food, serving size, servings per container, as well as the number of calories per serving, and a total amount of nutrient levels within the entire package, referring to paragraph [0020], lines 30 through 34. Even assuming all that the Examiner asserted in this regard is accurate, the fact remains that *Arrendale, III et al.* do not disclose an indication of the total number of calories in a package of food, which was the reason why the Examiner was compelled to resort to this reference. Rather, *Arrendale, III et al.* disclose a conventional label depicting the number of calories **per serving**. The retrospective calculation of the total number of calories in the package does not provide an adequate rationale as to why one having ordinary skill in the art would have been realistically led to **indicate on the package both** the number of calories per serving **and** the total number of calories in the entire package of food. As maintained by the Supreme Court of the United States in *KSR Intern. Co. v. Teleflex Inc.*, at 1741, an obviousness “analysis should be made explicit. See, *In re Kahn*, 441 F.3d 977, 988 (C.A. Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness”)

Since neither of the applied references discloses or suggests an indication of the total number of calories within the package of food, even if the applied references are combined as proposed by the Examiner, and Applicant again does not agree that the requisite basis to support the asserted motivation has been established, the invention defined in claim 33, and claims 34 through 39 and 85 through 87, dependent thereon would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*.

Claims 45 through 47 depend from independent claim 40. For the reasons argued above, *Rhee* does not disclose or suggest the “plurality of packages” of claim 40. The secondary reference to *Arrendale, III et al.* is of no help in this regard, as *Arrendale, III et al.* also disclose a single package of food. Accordingly, no *prima facie* case of obviousness has been established with regard to claims 45 through 47.

Claims 61 through 63 depend from independent claim 56. For the reasons argued above, *Rhee* does not disclose or suggest the “assembly of food products.” Neither do *Arrendale, III et al.* Accordingly, since neither of the applied references discloses or suggests an assembly of food products, no *prima facie* case of obviousness has been established with regard to claims 61 through 63.

Based on the foregoing Applicant, submits that the imposed rejection of claims 33 through 39, 45 through 47, 61 through 63 and 85 through 87 as being obvious under 35 U.S.C. § 103 based on *Rhee* and *Arrendale, III et al.* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 52 through 54 were rejected as obvious under 35 U.S.C. § 103 based on *Missler et al.* (US 6,359,239) in view of *Arrendale, III et al.* (US 2004/0045202).

This rejection is traversed. Specifically, claims 52 through 54 depend from independent claim 48. For the reasons advocated above in traversing the rejection of claim 48, there is no disclosure in *Missler et al.* regarding a pre-determined number of calories or either a derivation of or a presentation of **nutritional content** of the food product, let alone **in accordance with a pre-determined number of calories**. Since *Arrendale, III et al.* do not

cure this deficiency of *Missler et al.*, no *prima facie* case of obviousness has been established with regard to claims 52 through 54.

Applicant, therefore, submits that the imposed rejection of claims 52 through 54 as being obvious under 35 U.S.C. § 103 based on *Missler et al.* and *Arrendale, III et al.* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claim 60 was rejected as obvious under 35 U.S.C. § 103 based on *Rhee* (US 2001/0043968) in view of *Bukowski* (US 2003/0106940).

This rejection is traversed. Specifically, claim 60 recites “wherein the number of calories per serving of the food products is not displayed.” The food package in *Rhee* does display a number of calories. Fig. 6 of *Bukowski* shows a package of food wherein **no** display of a number of calories is apparent. However, the package in *Bukowski* is depicted for an entirely different purpose, *viz*, for a bar code, so it is unclear that such a package would not also normally indicate a number of calories per serving of food. The point is that *Bukowski* nowhere indicates that the package of food is intentionally lacking an indication of the number of calories per serving of food. But even if the package in *Bukowski* does not depict the number of calories per serving of food, one having ordinary skill in the art would certainly **not** have been led by such a teaching to undercut *Rhee*’s objective, destroying the very essence of *Rhee*’s invention, by specifically removing the indication of the number of calories per serving of food in *Rhee*. See, *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *In re Schulpen*, 390 F.2d 1009 (C.C.C.P. 1968).

Moreover, *Rhee*’s clear **teaching away** from removing the indication of a number of calories per serving of food, because the whole point of the invention of *Rhee* is to specifically

indicate this number of calories, undermines the Examiner's obviousness conclusion. A reference may be said to "teach away" when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Furthermore, claim 60 depends from claim 56. For the reasons argued above, *Rhee* does not disclose the "assembly of food products" of claim 56. The secondary reference to *Bukowski* does not cure this deficiency. Applicant, therefore, submits that the imposed rejection of claim 60 as being obvious under 35 U.S.C. § 103 based on *Rhee* and *Bukowski* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 66 through 73, 75 through 81, 83, 84, and 94 were rejected as obvious under 35 U.S.C. § 103 based on *Missler et al.* (US 6,359,239) in view of *Teraoka* (US 2003/0004750).

This rejection is traversed. Specifically, independent claim 66 recites, *inter alia*, "provide **other nutritional information based on the number of calories** and the particular type of food." For the reasons previously argued, *Missler et al.* do not provide "**other nutritional information based on the number of calories**", let alone based on both the number of calories and the particular type of food. The secondary reference to *Teraoka*, cited by the Examiner for an alleged teaching of determining a price for weighed food, does not cure this argued deficiency of *Missler et al.*

With regard to independent claim 94, for the reasons set forth below, *Missler et al.* do not disclose or suggest various claim features, particularly "dynamically determine caloric content

and at least one other piece of nutritional information for a particular quantity of food being weighed by the scale”, and **“nutritional information, along with a price for the particular quantity of food, is output to a display for presentation in accordance with a pre-determined number of calories.”** *Teraoka*, cited by the Examiner for an alleged teaching of determining a price for weighed food, do not cure these argued deficiencies of *Missler et al.*

Since neither of the applied references discloses or suggests the claim features: “provide **other nutritional information based on the number of calories** and the particular type of food”; and/or “dynamically determine caloric content **and at least one other piece of nutritional information** for a particular quantity of food being weighed by the scale”; or **“nutritional information, along with a price for the particular quantity of food, is output to a display for presentation in accordance with a pre-determined number of calories,”** even if the applied references are combined as proposed by the Examiner, and again Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicant, therefore, submits that the imposed rejection of claims 66 through 73, 75 through 81, 83, 84, and 94 as being obvious under 35 U.S.C. § 103 based on *Missler et al.* and *Teraoka* is not legally viable and, hence, solicits withdrawal thereof.

Claim 74 was rejected as obvious under 35 U.S.C. § 103 based on *Missler et al.* (US 6,359,239) in view of *Teraoka* (US 2003/0004750) and *Arrendale, III et al.* (US 2004/0045202).

This rejection is traversed. Specifically, claim 74 depends from claim 66 and recites “wherein the other nutritional information includes fat content, saturated fat content, trans fat

content, protein content, carbohydrate content, vitamin content, and/or mineral content.” Thus, claim 74 further specifies the “other nutritional content” which neither *Missler et al.* nor *Teraoka* disclose or suggest. The Examiner relied on *Arrendale, III et al.* to provide for this missing claim feature. However, *Arrendale, III et al.* merely disclose a conventional nutrition label 40, and do not “provide other nutritional information based on the number of calories and the particular type of food,” as recited in claim 74 via claim 66. Moreover, there is nothing within any of the applied references that would have suggested displaying the nutritional information of *Arrendale, III et al.* based on the number of calories and the particular type of food.

Since neither reference discloses or suggests “wherein the other nutritional information includes fat content, saturated fat content, trans fat content, protein content, carbohydrate content, vitamin content, and/or mineral content,” even if the applied references are combined as proposed by the Examiner, and again Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicant, therefore, submits that the imposed rejection of claim 74 as being obvious under 35 U.S.C. § 103 based on *Missler et al.*, *Teraoka*, and *Arrendale, III et al.* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claim 82 was rejected as obvious under 35 U.S.C. § 103 based on *Missler et al.* (US 6,359,239) in view of *Teraoka* (US 2003/0004750) and *Overman* (US 5,483,472).

This rejection is traversed. Specifically, claim 82 depends from claim 81, which depends from claim 66, and recites “wherein the price is determined in relation to the pre-determined number of calories and a unit price for the pre-determined number of calories is provided.” Neither *Missler et al.* nor *Teraoka* disclose or suggest “other nutritional

information **based on the number of calories and the particular type of food,**” as recited in claim 82 via claim 66.

The secondary reference to *Overman* is directed to a portable electronic food shopper. In one embodiment, a caloric count of foods consumed may be listed with total calories summed at the end of the list (col. 4, lines 6-8). However, nowhere in *Overman* is to be found any disclosure or suggestion of “other nutritional information **based on the number of calories and the particular type of food**” (as in claim 66) or “wherein the price is determined in relation to the pre-determined number of calories and a unit price for the pre-determined number of calories is provided” (as in claim 82). Moreover, there is nothing in any of the applied references that would have suggested the claim features: “other nutritional information **based on the number of calories and the particular type of food**”; or determining a price in relation to the pre-determined number of calories and a unit price for the pre-determined number of calories.

Since neither reference discloses or suggests “other nutritional information **based on the number of calories and the particular type of food**”, or determining a price in relation to the pre-determined number of calories and a unit price for the pre-determined number of calories, even if the applied references are combined as proposed by the Examiner, and again Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicant, therefore, submits that the imposed rejection of claim 82 as being obvious under 35 U.S.C. § 103 based on *Missler et al.*, *Teraoka*, and *Overman* is not factually or legally viable and, hence, solicits withdrawal thereof.

Claim 94 was rejected as obvious under 35 U.S.C. § 103 based on *Missler et al.* (US 6,359,239) in view of *Overman* (US 5,483,472).

This rejection is traversed. Specifically, independent claim 94 recites, in part, “a processor configured to dynamically determine caloric content **and at least one other piece of nutritional information** for a particular quantity of food being weighed by the scale” and “wherein the **nutritional information**, along with a price for the particular quantity of food, **is output to a display for presentation** in accordance with a **pre-determined number of calories**.” Neither *Missler et al.* nor *Overman* disclose or suggest these features.

The Examiner asserted, at page 29 of the Office Action, that *Missler et al.* disclose the first feature (“dynamically determine caloric content **and at least one other piece of nutritional information** for a particular quantity of food being weighed by the scale”) at col. 6, lines 14-39, and the second feature (“**nutritional information**, along with a price for the particular quantity of food, **is output to a display for presentation** in accordance with a **pre-determined number of calories**”) at col. 5, lines 37-45.

A review of these cited portions of *Missler et al.* reveals that calculations for a number of calories corresponding to a weight of a particular food is disclosed in col. 6, lines 14-39. But there is no disclosure or suggestion in *Missler et al.* of determining caloric “content **and at least one other piece of nutritional information** for a particular quantity of food being weighed by the scale.” *Overman* does not cure this argued deficiency.

A review of col. 5, lines 37-45 of *Missler et al.* reveals selector switches 40 that allow a user to input information such as, e.g., specifying certain parameters to be measured or displayed. However, neither this portion of *Missler et al.* nor any other portion of *Missler et al.* can be said to disclose or suggest that nutritional information is output to a display for presentation “in accordance with a **pre-determined number of calories**.”

The secondary reference to *Overman* is directed to a portable electronic food shopper. In one embodiment, a caloric count of foods consumed may be listed with total calories summed at the end of the list (col. 4, lines 6-8). However, nowhere in *Overman* is there any disclosure or suggestion of “dynamically determine caloric content **and at least one other piece of nutritional information** for a particular quantity of food being weighed by the scale”, or of “**nutritional information**, along with a price for the particular quantity of food, **is output to a display for presentation** in accordance with a **pre-determined number of calories.**”

Since neither of the applied references discloses or suggests the claim features: “dynamically determine caloric content **and at least one other piece of nutritional information** for a particular quantity of food being weighed by the scale”; or “**nutritional information**, along with a price for the particular quantity of food, **is output to a display for presentation** in accordance with a **pre-determined number of calories,**” even if the applied references are combined as proposed by the Examiner, and again Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra*. Applicant, therefore, submits that the imposed rejection of claim 94 as being obvious under 35 U.S.C. § 103 based on *Missler et al.* and *Overman* is not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration therefore is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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